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Docket No.: 06181-862002

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RESPOND

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Miriam MAWLE et al. Art Unit : 3714
Serial No. : 09/556,839 Examiner : Carmen White
Filed : April 21, 2000
Title : TOY FIGURE FOR USE WITH MULTIPLE, DIFFERENT GAME SYSTEMS

Commissioner for Patents
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REPLY TO ACTION OF DECEMBER 18, 2003

In reply to the Office Action of December 18, 2003, applicant submits the following remarks.

Claims 1-40 are pending with claims 1 and 34 being independent. Applicant thanks the Examiner for the indication that claims 34-39 are allowed.

Independent claim 1 relates to a game having a toy figure, a first game system, and a second game system. The toy figure includes memory for storing information relating to the toy figure. The first game system is configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and provide a representation of the toy figure when the first game system communicates with the toy figure. The second game system is configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and provide a representation of the toy figure when the second game system communicates with the toy figure.

Claims 1-3, 5, 7-33, and 40 have been rejected as being obvious over U.S. Patent No. 6,012,961 (Sharpe) in view of U.S. Patent No. 5,752,880 (Gabai) and U.S. Patent No. 5,853,327 (Gilboa). Applicant requests withdrawal of this rejection because Sharpe fails to describe or suggest providing a representation of a toy figure when a game system communicates with the toy figure and one of ordinary skill in the art would have had no motivation to modify Sharpe using Gabai and Gilboa in the manner suggested in the Office Action.

Sharpe's system is designed to provide a user with the ability to interact directly with a toy and to change the operating characteristics of the toy. See Sharpe at col. 1, lines 7-13. As discussed previously, and as agreed by the Examiner, Sharpe does not provide a representation of

the toy. Rather, Sharpe provides a system for reprogramming and operating the toy. See Sharpe at Abstract. Accordingly, Sharpe fails to describe or suggest a game system that provides a representation of a toy figure when the game system communicates with the toy figure, as recited in claim 1.

Like Sharpe's system, Gabai's system provides a user with the ability to interact directly with a toy and to change the operating characteristics of the toy. See Gabai at Abstract. As the Examiner agrees, Gabai fails to cure the deficiencies of Sharpe. Gabai's computer system does not display the image of the toy when the computer system communicates with the toy. See Gabai at col. 9, lines 24-60 and Figs. 2A-2C. Accordingly, Gabai also fails to describe or suggest a game system that provides a representation of a toy figure when a game system communicates with the toy figure, as recited in claim 1.

Gilboa relates to a game system that senses a location of a toy figure on a game board and actuates an audio/visual display of the toy figure in response to the sensing. See Gilboa at Abstract. Gilboa's system provides a user with the ability to control operation of the display by moving the toy figure around the game board. See Gilboa at col. 3, lines 11-18 and Figs. 2A-2E.

Nothing in Gilboa, Sharpe, or Gabai would have motivated one of ordinary skill in the art to modify Sharpe's system to include the audio/visual display of Gilboa. Both Sharpe and Gabai relate to systems in which the user controls operation of and interacts with the physical toy. The computers in Sharpe's and Gabai's systems are used to change operating characteristics of the toy to make interactions with the toy more interesting. The principle of operation of Sharpe's system is to provide the user with the ability to interact with the toy and to use the computer to operate the toy.

By contrast, Gilboa's system displays a representation (that is, an audio/visual display) of the game piece and the user interacts with the audio/visual display. The user of Gilboa's system does not interact with the game piece. Rather, the user merely moves the game piece across a game board. As such, any modification of Sharpe's system in view of Gilboa would require the user to interact with an audio/visual display of the toy, and, accordingly, would change the principle of operation of Sharpe's system.

According to the Office Action, "[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to employ this feature, as taught by Gilboa, in Sharpe and Gabai to make the game more realistic and fun for smaller children." However, this statement is conclusory in that it fails to provide some objective reason to modify Sharpe. See MPEP §2143.01. Moreover, the mere fact that Sharpe could be modified would not have made modification obvious unless the prior art suggested the desirability of the modification. See MPEP §2143.01.

In summary, the Sharpe, Gilboa, and Gabai fail to teach or suggest a motivation to modify Sharpe in the manner suggested in the Office Action. For at least this reason, applicant respectfully submits that the prior art does not support a prima facie case of obviousness. Accordingly, claim 1 is allowable over Sharpe in view of Gabai and Gilboa.

Claims 2, 3, 5, 7-33, and 40 depend from claim 1 and are allowable for at least the reason that claim 1 is allowable and for containing allowable subject matter in their own right. For example, claim 10 recites that the input received from a user includes input relating to control of the representation of the toy figure during game play. None of the cited art, alone or in combination, describes or suggests receiving input relating to control of the representation of the toy figure during game play.

Claims 4 and 6 have been rejected as being obvious over Sharpe in view of Gabai, Gilboa, and U.S. Patent No. 5,746,602 (Kikinis), which relates to a doll that is controlled through a computer when the doll is communicating with the computer. See Kikinis at col. 3, lines 23-53 and line 66 to col. 4, line 17. Kikinis' computer never provides a representation of the doll.

Applicant requests reconsideration and withdrawal of this rejection because one of ordinary skill in the art would have had no motivation to combine Kikinis, Gilboa, Gabai, and Sharpe to produce the subject matter of claim 1, from which claims 4 and 6 depend. As discussed above, Sharpe fails to describe or suggest a game system that provides a representation of a toy figure when the game system communicates with the toy figure, and nothing in Sharpe, Gilboa, and Gabai would have motivated one of ordinary skill in the art to modify Sharpe in the manner suggested. Moreover, nothing in Kikinis would have motivated one of ordinary skill in

the art to modify Sharpe using the audio/visual display of Gilboa. Kikinis, like Sharpe and Gabai, relates to a system that controls operation of the doll itself. Thus, a user of Kikinis's system interacts directly with the doll when playing with the doll. Kikinis provides no motivation to do otherwise. Indeed, Kikinis stresses the importance of the interactivity between the doll and the user while teaching away from interactivity between the user and the computer. Kikinis explains "[a] doll is a personal entity with which a child or adult may interact" and "one cannot expect a young child to sit for long in front of a computer or to interact with the computer [though] [a] young child will ... interact with a doll, and may be expected to interact very strongly and closely with a very sophisticated doll." See Kikinis at col. 1, lines 16-18 and 41-45 and col. 2, lines 35-48.

In summary, Sharpe fails to describe or suggest a game system that provides a representation of a toy figure when the game system communicates with the toy figure, and Sharpe, Gilboa, Gabai, and Kikinis fail to teach or suggest a motivation to modify Sharpe in the manner suggested in the Office Action. For at least this reason, applicant respectfully submits that the prior art does not support a prima facie case of obviousness. Accordingly, claim 1 is allowable over Sharpe in view of Gabai, Gilboa, and Kikinis, as are claims 4 and 6, which depend from claim 1.

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Respectfully submitted,

Date: March 16, 2004

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